

Matthew D. Murphey, Esq. (SBN 194111)
TROUTMAN SANDERS LLP
11682 El Camino Real, Suite 400
San Diego, CA 92130-2092
Tel: (858) 509-6000 / Fax: (858) 509-6040
Email: matt.murphey@troutmansanders.com

Francis M. Wikstrom, Esq. (admitted *pro hac vice*)
Kristine E. Johnson, Esq. (admitted *pro hac vice*)
PARSONS BEHLE & LATIMER
One Utah Center
201 South Main Street, Suite 1800
Post Office Box 45898
Salt Lake City, UT 84145-0898
Tel.: (801) 532-1234 Fax: (801) 536-6111
Email: fwikstrom@parsonsbehle.com
kjohnson@parsonsbehle.com

Attorneys for Plaintiffs and Counter-defendants LIFE
TECHNOLOGIES CORPORATION, MOLECULAR
PROBES, INC. and THE REGENTS OF THE
UNIVERSITY OF CALIFORNIA

Polaphat Veravanich, Esq. (SBN 203964)
LIFE TECHNOLOGIES CORPORATION
5791 Van Allen Way
Carlsbad, CA 92008
Tel.: (760) 603-7200 Fax: (760) 476-6048
Email: paul.veravanich@lifetech.com

Attorney for Plaintiffs and Counter-defendants
LIFE TECHNOLOGIES CORPORATION and
MOLECULAR PROBES, INC.

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

LIFE TECHNOLOGIES CORPORATION,
MOLECULAR PROBES, INC., and THE
REGENTS OF THE UNIVERSITY OF
CALIFORNIA,

Plaintiffs,

v.

EBIOSCIENCE, INC.,

Defendant.

AND RELATED COUNTERCLAIMS.

Case No. 10-CV-02127 IEG (NLS)

**MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT OF
JOINT MOTION FOR
DETERMINATION OF DISCOVERY
DISPUTE**

1 Plaintiffs/Counterdefendants LIFE TECHNOLOGIES CORPORATION, MOLECULAR
 2 PROBES, INC., and THE REGENTS OF THE UNIVERSITY OF CALIFORNIA (collectively
 3 “Plaintiffs”), and Defendant/Counterclaimant EBIOSCIENCE, INC. (“Defendant”) respectfully
 4 submit the following Memorandum of Points and Authorities in support of the Joint Motion for
 5 Determination of Discovery Dispute:

6 I.

7 PLAINTIFFS’ POSITION

8 A. Summary of Argument

9 Through this Motion, Plaintiffs seek an order compelling Defendant to comply with its
 10 obligations under Patent Local Rule¹ 3.4.a and the Court’s Case Management Conference Order
 11 (“Scheduling Order”). Despite numerous attempts to meet and confer, Defendant refuses to
 12 produce certain categories of technical documents describing the accused eFluor® products (the
 13 “Accused Products”), namely:

- 14 1. Manufacturing documents, process flow maps, and quality control protocols
 15 that describe details and processes relating to the Accused Products such as the
 16 manufacture of the core; the manufacture of the shell; the formation of the
 17 shell around the core; the materials for any coatings around the shell and the
 18 formation of any coatings around the shell; and, for conjugated products, the
 19 attachment of the conjugates to the coating of the Accused Products;
- 20 2. Up-to-date and complete manufacturing batch records; and
- 21 3. Packaging protocols for the current Accused Products.

22 Defendant cannot dispute that these documents fit squarely within the production required
 23 by Rule 3.4.a, nor does Defendant deny that it is in possession of them. Rather, Defendant asserts
 24 baseless objections to their production—none of which can be sustained here.

25 As its primary objection, Defendant contends that production of the requested documents
 26 is premature because: (a) Defendant’s Motion to Stay Action Pending its Request for
 27

28 ¹ Hereinafter “Patent L.R.” or simply “Rule.”

1 Reexamination of the Patents-In-Suit (“Motion to Stay”) is pending before the Court; and (b)
2 Defendant is currently in the process of reviewing its document collection such that production of
3 a subset of technical documents now would be inefficient or burdensome. Neither of these
4 arguments is compelling, and Defendant is hard-pressed to claim that production is premature or
5 burdensome when Plaintiffs were entitled to these documents long ago and as a matter of right.
6 Further, this Court has not granted any stay, and until a stay is granted (if it is), Plaintiffs are
7 entitled to proceed with discovery. Defendant cannot be allowed to create its own de facto stay of
8 the case by disregarding its obligations under Rule 3.4.a.

9 Defendant also objects on the basis that it has already produced documents sufficient to
10 describe the structure and operation of the Accused Products. This is incorrect. Defendant has
11 not produced manufacturing protocols, up-to-date batch records, or packaging protocols for the
12 Accused Products—documents that are essential to understanding the operation and processes of
13 the Accused Products. Instead, Defendant has produced only two Power Point presentations, one
14 of which appears to have been prepared by a *third party*, Evident Technologies, Inc. (“Evident”),
15 several years ago; three patents that allegedly describe features of the Accused Products; one
16 spreadsheet with a limited data set; and a handful of materials from its website. However, these
17 documents appear to be outdated and do not describe or confirm the operations or processes of
18 the Accused Products today. In any event, Defendant misconstrues its obligations under Rule
19 3.4.a, which requires defendants to produce *all* documents that describe the operation or
20 structures of an accused product—not merely documents that may be “sufficient” to describe
21 them. *I-Flow Corp. v. Apex Med. Techs., Inc.*, 250 F.R.D. 508, 511 (S.D. Cal. 2008).

22 Finally, Defendant questions the relevance of the requested technical documents to claim
23 construction. This argument is beside the point given that Defendant had a mandatory duty to
24 produce them under Rule 3.4.a. Nevertheless, it is well-settled that documents describing accused
25 products and their processes are relevant to claims construction in that they provide essential
26 context and supply the parameters and scope of the infringement analysis, including the claims
27 construction component. *See Wilson Sporting Goods Co. v. Hillerich & Bradsby Co.*, 442 F.3d
28 1322, 1330-31 (Fed. Cir. 2006).

1 In sum, Defendant provides no valid justification for withholding documents that should
2 have been produced per Patent L.R. 3.4.a and this Court's Scheduling Order. Thus, this Court
3 should grant Plaintiffs' Motion and order that the requested documents be immediately produced
4 without further objection or delay. Furthermore, as a result of Defendant's delay in production,
5 Plaintiffs will have insufficient time to review the documents before the July 22, 2011 deadline
6 for filing the Joint Claim Construction Chart, Joint Claim Construction Worksheet and Joint
7 Hearing Statement ("Joint Claim Construction Statement"). As such, Plaintiffs request that the
8 Court continue this deadline, if necessary, by providing Plaintiffs with fourteen days from the
9 date of Defendant's production to allow time for complete analysis of Defendant's technical
10 documents before filing the Joint Claim Construction Statement. Such an extension should not
11 impact the briefing schedule or the hearing date.

12 **B. Statement of Relevant Facts**

13 Plaintiffs filed this patent infringement action against Defendant on October 12, 2010,
14 alleging Defendant infringed U.S. Patent Letters Nos. 6,423,551 (the "'551 Patent"), 6,699,723
15 (the "'723 Patent"), and 6,927,069 (the "'069 Patent") by making, manufacturing, promoting,
16 marketing, advertising, distributing, offering for sale and selling, and/or causing to be offered or
17 sold certain eFlour® products. On January 6, 2011, Defendant filed its Answer and Counterclaim
18 against all Plaintiffs. Plaintiffs subsequently filed a First Amended Complaint on April 11, 2011.

19 On March 4, 2011, the Court issued its Scheduling Order, setting forth pretrial dates and
20 deadlines. Pursuant to Scheduling Order, on March 16, 2011, Plaintiffs served their Disclosure of
21 Asserted Claims and Preliminary Infringement Contentions, as well as their production pursuant
22 to Patent L.R. 3.2. On May 16, 2011, Defendant served its Preliminary Invalidity Contentions
23 and documents pursuant to Rule 3.4.a via email and Federal Express, respectively.

24 On May 25, 2011, counsel for Plaintiffs contacted counsel for Defendant explaining the
25 deficiencies in Defendant's production of technical documents and requesting that Defendant
26 supplement its production under Rule 3.4.a. On June 3, 2011, Defendant responded by asserting
27 that documents such as manufacturing protocols or packaging protocols were not required to be
28 produced under Rule 3.4.a. Plaintiffs replied on June 8, 2011, explaining that the requested

documents were required by Rule 3.4.a. Later, in a June 16, 2011 letter, Plaintiffs requested the immediate production of the technical documents. On June 21, Defendant responded by refusing to produce the requested documents, while at the same time “propos[ing] [to] wait[] to further discuss the parties’ respective document productions for a few weeks to provide the Court some time to rule on eBioscience’s motion to stay.”

On June 24 and 27, Plaintiffs and Defendant engaged in telephonic meet and confers, but were unable to reach an agreement on Defendant’s production of technical information. Accordingly, Plaintiffs have been forced to proceed with this Motion.

C. Plaintiffs Are Entitled To The Requested Documents Under Patent L.R. 3.4.a.

Patent L.R. 3.4 provides, in relevant part:

With the “Preliminary Invalidity Contentions,” the party opposing a claim of patent infringement must produce or make available for inspection or copying:

a. Source code, specifications, schematics, flow charts, artwork, formulas, or other documentation sufficient to show the operation of any aspects or elements of any Accused Instrumentality identified by the patent claimant in its Patent L.R. 3.1.c chart;

Rule 3.4.a requires a patent infringement defendant to produce technical documents demonstrating the operation and processes of the accused products. *See also* Scheduling Order, at ¶ 6. This Court has taken a broad view of the production requirement under Rule 3.4.a. In *I-Flow Corporation v. Apex Medical Technologies, Inc.*, 250 F.R.D. 508 (S.D. Cal. 2008), this Court examined the scope of the production requirement under Rule 3.4.a. In-so-doing, the Court evaluated and agreed with the Southern District’s ruling in *NessCap Company, Ltd. v. Maxwell Technologies*, 2008 U.S. Dist. LEXIS 3357 (S.D. Cal. Jan. 16, 2008), which held that Patent L.R. 3.4.a “requires the alleged infringer to produce ‘**any and all documents**’ describing the operation or structures of [the] accused devises....” *I-Flow Corp.*, 250 F.R.D. at 511, *quoting* *NessCap Co., Ltd.*, 2008 U.S. Dist. LEXIS 3357, at *8 (emphasis in original).

In *I-Flow Corporation*, the plaintiff objected to the defendant’s Rule 3.4.a production on the basis that it was inadequate, consisting of only 13 pages of documents, including an eight-page sales brochure and five pages of drawings. *I-Flow Corp.*, 250 F.R.D. at 510. In response,

defendant argued that the production complied with Rule 3.4 because it contained documents “sufficient” to show the accused device’s operation. *Id.* This Court rejected defendant’s argument, finding that Patent L.R. 3.4.a requires a defendant to broadly produce “any and all” documents in its possession that describe the operation or structures of the accused products. *Id.*; *see also Cryptography Research, Inc. v. Visa Int’l Serv. Ass’n*, 2005 U.S. Dist. LEXIS 37013, at *9 (N.D. Cal. July 27, 2005) (holding that the defendant was required to produce all information in its possession which fit the plaintiff’s broader definition of the Rule 3-4 requirements); *IXYS Corp. v. Advanced Power Tech., Inc.*, U.S. Dist. LEXIS 10934, *8 (N.D. Cal. June 15, 2004) (stating that the Patent Local Rules “exist to further the goal of full, timely discovery and provide the parties with adequate notice and information with which to litigate their cases, not to create supposed loopholes through which the parties may practice litigation by ambush.”)

The facts in *I-Flow Corporation* are nearly identical to the facts in this discovery dispute. Here, the only technical documents Defendant has produced are two Power Point presentations, at least one of which appears to have been prepared by another company, Evident, years ago, one spreadsheet, and a number of product sheets and printouts from its website. Defendant has also produced certain patents that allegedly describe features of the Accused Products. However, all of these documents appear to be years old, or do not describe or confirm the operation, processes, or manufacturing of the Accused Products today, or both. This production is inadequate under Patent L.R. 3.4.a and the authorities interpreting it, and further fails to comport with the entire purpose and spirit of the Patent Local Rules, which is to enable the parties to “crystallize their theories of the case early in the litigation and to adhere to those theories once they have been disclosed.” *Cryptography Research, Inc.*, 2005 U.S. Dist. LEXIS 37013, at *5-6, *quoting Integrated Circuit Sys. v. Realtek Semiconductor Co.*, 308 F.Supp.2d 1106, 1107 (N.D. Cal. 2004). Accordingly, Defendant should be ordered to supplement its Rule 3.4.a production by producing “any and all” technical documents in its possession, custody, or control.

1. Production Cannot Be Withheld Due To The Pending Motion To Stay Or On The Basis Of Undue Burden

While Defendant does not deny that it is in possession of additional technical documents,

1 Defendant argues that production is premature in light of Defendant's pending Motion to Stay.
2 This argument lacks any basis in law, especially given that Defendant should have produced these
3 documents over a month ago. In any event, this Court has not granted any stay and until a stay is
4 granted, Defendant has no right to withhold production. Indeed, Plaintiffs are being prejudiced
5 with each passing day that they are not in possession of these technical documents, especially as
6 the July 22, 2011 deadline for the parties' Joint Claim Construction Statement rapidly approaches
7 and Plaintiffs are without the necessary documents to prepare their claim constructions.

8 Defendant also claims that producing these technical documents now would be inefficient,
9 as Defendant is currently reviewing its collection of documents, and compliance with Plaintiffs'
10 demand would require identification and production of a subset of technical documents now. To
11 the extent that Defendant's argument is based on undue burden, it is entirely without merit.

12 It is well-established that the burden falls on the objecting party to demonstrate undue
13 burden. *In re Toys "R" Us-Delaware, Inc.*, 2010 U.S. Dist. LEXIS 130884, at *19-20 (C.D. Cal.
14 July 29, 2010) (stating that the party objecting to discovery must set forth specific grounds as to
15 how, despite the liberal construction afforded federal discovery rules, the request is overbroad or
16 unduly burdensome). Indeed, "[m]erely because compliance with a 'Request for Production'
17 would be costly or time-consuming is not ordinarily sufficient reason" to preclude production of
18 relevant documents. *Id.* at *22 (citation omitted). Similarly, "[t]he fact that production of
19 documents would be burdensome and...would hamper the party's business operations[,] may not
20 be a reason for refusing to order production of relevant documents." *Santa Monica Baykeeper v.*
21 *Kramer Metals, Inc.*, 2009 U.S. Dist. LEXIS 69130, at *23 (C.D. Cal. Feb. 27, 2009) (internal
22 quotes and citation omitted). Further, the objecting party must demonstrate that the alleged
23 burden outweighs the likely benefits of the discovery. *See Baker v. Ark. Blue Cross*, 2009 U.S.
24 Dist. LEXIS 50367, at *4 (E.D. Cal. May 29, 2009).

25 Here, Defendant cannot validly assert that it would be unduly burdensome to produce
26 manufacturing protocols, up-to-date and complete manufacturing batch records, and packaging
27 protocols for the current Accused Products, especially when these documents should have been
28 produced with Defendant's Rule 3.4.a production. Further, Defendant can hardly assert that

1 production would be unduly expensive or time consuming when Plaintiffs have identified the
 2 specific categories of documents they seek, all of which are readily searchable. It is inequitable
 3 for Defendant to refuse to expend what is a relatively nominal cost in searching for and producing
 4 documents that should have been produced long ago. In any event, any supposed burden in
 5 production is outweighed by the necessity and relevance of these documents.

6 2. The Requested Documents Are Necessary For Claim Construction, And The Court
 7 Should Continue The Date For Filing The Joint Claims Construction Statement To
Allow Plaintiffs Sufficient Time To Analyze Defendant's Technical Documents

8 Finally, as previously stated, the necessity of the requested documents is heightened given
 9 the rapidly approaching deadline for filing the Joint Claim Construction Statement in this action.
 10 While Defendant questions the relevance of technical documents to claim construction, the courts
 11 have consistently affirmed their relevance. In *Wilson Sporting Goods Co. v. Hillerich & Bradsby*
 12 *Co.*, the Federal Circuit held that, while claims may not be construed with *reference* to an accused
 13 device, this does not “forbid awareness of the accused product or process to supply the
 14 parameters and scope of the infringement analysis, including its claim construction component.”
 15 442 F.3d 1322, 1331 (Fed. Cir. 2006).

16 In *Wilson Sporting Goods Co.*, the plaintiff appealed the district court’s construction of
 17 claims terms. In its opinion, the Federal Circuit took specific note of the lack of description of
 18 the accused infringing devices in the record and held that, “[w]ithout that additional context, [it
 19 could not] fully and confidently review the infringement judgment, including its claim
 20 construction component.” *Id.* at 1330. The court’s opinion affirms that documents relating to the
 21 operation and processes of the accused instrument are entirely relevant to claim construction
 22 because they provide meaningful and necessary context for construction. *See id.* at 1326-27; *see*
 23 *also Elan Microelectronics Corp. v. Apple, Inc.*, 2010 U.S. Dist. LEXIS 122011, at *26-27 (N.D.
 24 Cal. Nov. 1, 2010) (quoting *Wilson Sporting Goods Co.*, 442 F.3d at 1326-27 (“While a trial court
 25 should certainly not prejudge the ultimate infringement analysis by construing claims with an aim
 26 to include or exclude an accused product or process, knowledge of that product provides
 27 meaningful context for the first step in the infringement analysis, claim construction.”); *see also*
 28 *McKesson Info. Solutions LLC v. Epic Sys. Corp.*, 495 F.Supp.2d 1329, 1335 (N.D. Ga. 2007).

1 Here, Defendant has endeavored to “blindfold” Plaintiffs in their claim construction
2 analysis by withholding documents necessary to provide essential context for their constructions.
3 As stated, these documents should have been produced as part of Defendant’s Rule 3.4.a
4 production, and must now be produced without further objection. Furthermore, due to the delay
5 in Defendant’s production of technical documents, Plaintiffs request that the Court continue the
6 July 22, 2011 deadline for filing the Joint Claims Construction Statement by providing Plaintiffs
7 with fourteen days from the date of Defendant’s actual production to allow Plaintiffs adequate
8 time to analyze Defendant’s technical documents. Indeed, the Patent Local Rules contemplate
9 that the parties will have the benefit of this context by requiring infringement contentions,
10 invalidity contentions, and the defendant’s production of technical documents prior to claim
11 construction proceedings. Patent L.R. App. C (“Time Line of Exchange and Filing Dates”); *see*
12 *McKesson Info. Solutions LLC*, 495 F.Supp.2d at 1335 (adjusting claim construction deadlines to
13 allow the plaintiff time to review the defendants’ compelled production of technical documents
14 prior to exchanging preliminary constructions).

15 **D. Conclusion**

16 Defendant cannot provide any valid justification for withholding technical documents that
17 should have been produced under Patent L.R. 3.4.a and this Court’s Scheduling Order. Despite
18 numerous requests and meet and confer efforts, manufacturing protocols, up-to-date and complete
19 manufacturing batch records, and packaging protocols for the current Accused Products have not
20 been produced. What Defendant has produced is not only insufficient, but it is outdated and
21 unreliable. Thus, for the reasons provided herein, Plaintiffs request that the Court order
22 Defendant to produce all technical documents required under Patent L.R. 3.4.a and the Court’s
23 Scheduling Order without further objection or delay.

24 **II.**

25 **DEFENDANT’S POSITION**

26 Defendant eBioscience, Inc. (“eBioscience”), by and through its undersigned counsel,
27 submits this memorandum of points and authorities in opposition to Plaintiffs’ motion to compel
28

1 the production of certain eBioscience documents. eBioscience met and conferred with counsel
 2 for Plaintiffs Life Technologies Corp., Molecular Probes, Inc. and the Regents of the University
 3 of California (“Plaintiffs”) regarding this motion, and the parties were unable to reach agreement.

4 **I. INTRODUCTION**

5 By their motion, Plaintiffs move to compel the production of documents including
 6 eBioscience’s manufacturing protocols, up-to-date and complete manufacturing batch records,
 7 and packaging protocols for the accused products. Plaintiffs assert that this information should
 8 have been included with eBioscience’s Patent L.R. 3.4.a disclosures.

9 To the contrary, Plaintiffs’ motion should be denied at least because: (1) eBioscience
 10 complied with the requirements of Patent L.R. 3.4.a; (2) the patent claims at issue are to
 11 compositions, not manufacturing processes; (3) the patent claims will undoubtedly change as part
 12 of the reexamination process now underway, thereby changing the claim construction and
 13 infringement-related issues in the case; and (4) the parties’ remaining costly and burdensome
 14 document production efforts should not commence until after the Court issues its decision on
 15 eBioscience’s pending motion to stay. Significantly, notwithstanding its motion to stay,
 16 eBioscience continues to move forward with its obligations relating to the claim construction
 17 phase. Since filing its motion for stay, eBioscience has served its preliminary and rebuttal claim
 18 construction positions and agreed to provide supplementation to discovery responses even though
 19 their relevance to the claim construction phase of the case is tenuous at best, especially now that
 20 reexamination has been ordered.

21 **II. FACTUAL BACKGROUND**

22 **A. eBioscience’s Patent Local Rule 3.4.a Document Production**

23 eBioscience served its Invalidity Contentions and accompanying document production
 24 pursuant to Patent L.R. 3.3 and 3.4 on May 16, 2011. (Tempesta Decl. Exh. 1).² As required by
 25 Patent L.R. 3.4.a, eBioscience produced “documentation sufficient to show the operation of any
 26

27 ² Citations to Tempesta Decl. refer to the Declaration of Jennifer C. Tempesta in Support of
 28 eBioscience’s Portion of the Parties’ Joint Motion for Determination of Discovery Dispute No. 2,
 submitted contemporaneously herewith.

1 aspects or elements” of the accused products. Specifically, eBioscience produced almost 200
2 pages of documents including detailed PowerPoint presentations, spreadsheets, patents, and
3 information available at eBioscience’s website showing the composition of the accused products.
4 (Tempesta Decl. Exh. 2).

5 Despite this production, on June 21 (more than a month after eBioscience’s production),
6 Plaintiffs took the position that eBioscience has not provided enough information about the
7 accused products to proceed with the claim construction phase of the case. eBioscience disagrees
8 that any additional document production is needed in advance of claim construction. However, in
9 an attempt to reach agreement with Plaintiffs on this issue, at Plaintiffs’ request, eBioscience
10 agreed to provide by July 6 the specific column and line numbers from the patents it produced in
11 connection with Patent Local Rule 3.4.a, to better inform Plaintiffs which portions of those
12 patents are practiced by eBioscience in manufacturing the accused products. eBioscience also
13 agreed to provide a supplemental response to Plaintiffs’ Interrogatory No. 4 by July 8 relating to
14 why eBioscience does not infringe the Patents-in-Suit.³ eBioscience requested that Plaintiffs
15 wait to receive this information from eBioscience to determine whether this supplementation is
16 sufficient to meet Plaintiffs’ concerns. Plaintiffs refused and instead insisted on filing this motion
17 to obtain additional documents from eBioscience immediately. Plaintiffs have also failed to
18 articulate why documentation detailing eBioscience’s highly proprietary *methods* of
19 manufacturing is relevant to the accused end product *compositions* in view of the fact that only
20 *composition* patent claims are at issue in this case. Moreover, Plaintiffs have not identified which
21 composition claim elements, if any, they feel have not yet been disclosed in eBioscience’s
22 document production.

23 ³ Plaintiffs’ Interrogatory No. 4 provides: “For each method, process, operation, application,
24 service, product, reagent, kit, or system identified in Interrogatory No. 1 [*i.e.*, products
25 eBioscience incorporates or uses in connection with semiconductor nanocrystals] that You assert
26 does not infringe one or more of the claims of the Patents-in-Suit, identify the claims that You
27 assert would not be infringed; all bases on which You rely to contend that any such claims would
28 not be infringed either literally or under the doctrine of equivalents including any basis on which
You rely to assert that Life Tech is estopped from asserting infringement by the doctrine of
equivalents; all facts on which You rely for Your assertion; and all documents and circumstances
relating to those facts and all persons with knowledge of those facts.”

1 B. eBioscience’s Motion to Stay the Case Pending Reexamination

2 eBioscience filed a motion to stay this case pending *ex parte* reexamination in the U.S.
 3 Patent and Trademark Office (“PTO”) of U.S. Patent No. 6,423,551 (“the ‘551 Patent”), U.S.
 4 Patent No. 6,699,723 (“the ‘723 Patent”) and U.S. Patent No. 6,927,069 (“the ‘069 Patent”)
 5 (collectively, “the Patents-in-Suit) on May 18, 2011. (Dkt. 43). Plaintiffs filed an opposition on
 6 June 6 (Dkt. 45), and eBioscience filed a reply on June 13. (Dkt. 52). The Court took
 7 eBioscience’s motion under submission and the parties await a ruling on the pending motion to
 8 stay. (*See* Dkt. 55). Just this week, the PTO granted the request for reexamination of the ‘551
 9 Patent. (Tempesta Decl. Exh. 6). Statistically, there is an overwhelming likelihood that the other
 10 two requests will also be granted in due course.⁴ (*See generally* Dkt. 43). Once the PTO orders
 11 reexamination, 77% of the time claims are cancelled or modified (*see* Dkt. 52 at 8), meaning
 12 claim construction and infringement issues, among others, will change if not altogether be
 13 rendered moot.

14 **III. ARGUMENT**

15 A. eBioscience Complied with Patent Local Rule 3.4.a

16 In compliance with Patent L.R. 3.4.a, eBioscience produced “documents sufficient to
 17 show the operation of any aspects or elements” of the accused products. (*See* Tempesta Decl.
 18 Exhs. 1-2). The documents produced by eBioscience show the composition or elements of the
 19 accused products. (*See id.*). Moreover, in an effort to compromise with Plaintiffs, eBioscience
 20 agreed to identify the specific portions of the patents it practices in making the accused products,
 21 and supplement its response to Plaintiffs’ Interrogatory No. 4 relating to eBioscience’s non-
 22 infringement positions. While eBioscience disputes that any of this additional information is
 23 necessary for claim construction to proceed, the provision of this information is undoubtedly
 24 sufficient for the purposes of claim construction. Plaintiffs have not identified a specific need for
 25 eBioscience’s highly confidential manufacturing documents at this juncture in the case.
 26 Importantly, the patent claims Plaintiffs assert eBioscience is infringing are all *composition* or

27 _____
 28 ⁴ If acted upon as quickly as the ‘551 Patent request, a PTO decision on the two remaining patents
 would issue in July.

1 *product* claims – none are directed to the *method* of manufacturing the products. This Court has
2 read “Patent Local Rule 3.4(a) as requiring the responding party to provide the raw data (source
3 code, schematics, formulas, etc.) sufficient to show the operation of the accused aspects of the
4 products in order to allow the patentee to make its own determinations as to infringement.”
5 *NessCap Co., Ltd. v. Maxwell Techs., Inc.*, No. 07-0704, 2008 WL 152147, at *3 (S.D. Cal. Jan.
6 16, 2008). That is precisely what eBioscience has done. eBioscience’s manufacturing methods
7 are not germane to the determination of infringement of the asserted *composition* claims.
8 Moreover, Plaintiffs have not identified any claim elements they contend were not covered by
9 eBioscience’s document production.

10 In contrast to this Court’s decision in *I-Flow Corp. v. Apex Medical Techs., Inc.*, 250
11 F.R.D. 508, 510 (S.D. Cal. 2008), where only 13 pages of documents had been produced, and at
12 least some of them were created specifically for the purpose of the litigation at issue, eBioscience
13 has produced almost 200 pages of documents pursuant to Patent L.R. 3.4.a (bearing Bates Nos.
14 EBIO0004735-4913). All of these are pre-existing documents that detail the *composition* of the
15 accused products.

16 Thus, Plaintiffs’ insistence that they are entitled to eBioscience’s highly sensitive
17 manufacturing documents at this time is entirely without merit. Such documents are not required
18 to meet eBioscience’s obligations under Patent L.R. 3.4.a, nor are they relevant to the claim
19 construction phase of this case.

20 B. The Parties’ Document Production Efforts Should Continue after the
21 Court Issues Its Decision on eBioscience’s Motion to Stay the Case

22 In their instant motion, Plaintiffs are limiting their argument for production of documents
23 to what is required pursuant to Patent L.R. 3.4.a. Yet the documents they seek go beyond that
24 rule. eBioscience has already collected all documents potentially relevant to this entire action
25 from agreed-upon custodians and is waiting to process these documents for production in this
26 case until after the Court decides eBioscience’s pending motion to stay. Plaintiffs appear to be
27
28

1 doing the same.⁵ It will be very costly for eBioscience to have its document production vendor
 2 begin to process all of these collected documents and unduly costly and inefficient to cull, review
 3 and process only the subset of documents currently being pursued by Plaintiffs – documents that
 4 are beyond the scope of what is required under Local Rule 3.4.a. Moreover, it would be
 5 inefficient to engage in the process of producing all of eBioscience’s potentially relevant
 6 documents if the Court soon thereafter decides to grant eBioscience’s motion to stay. Where, as
 7 here, (1) a litigation is in its early stages; (2) a stay would not cause undue prejudice to Plaintiffs
 8 (especially in view of the fact Plaintiffs waited two years to bring this action); and (3) a stay will
 9 likely simplify the issues for trial, courts routinely grant motions to stay pending reexamination.
 10 *See, e.g., Dataquill Ltd. v. High Tech Computer Corp.*, No. 08-cv-543, 2009 WL 1391537, at *1
 11 (S.D. Cal. May 14, 2009). (*See also* Dkt. 43). Thus, in view of the likelihood that the Court will
 12 grant the motion to stay, or at least soon decide it, and that the issues in the case will change,
 13 proceeding with major document productions now, especially beyond what is required under the
 14 Local Rules, would be inefficient, a waste of the parties’ resources and an unfair burden on
 15 eBioscience.

16 Plaintiffs’ sudden “need” for these documents for claim construction on the eve of the
 17 Court’s decision on a stay is highly suspect. eBioscience, at great burden and expense and
 18 beyond its obligations under the rules, is being asked to provide in house counsel of a competitor
 19 with these highly proprietary “process” documents with little if any relevance to this matter and
 20 no relevance to the claim construction phase of this case concerning “composition” claims now
 21 underway. Assuming *arguendo* the documents have some relevance as of today, they may have
 22 no relevance once the reexaminations of the Patents-in-Suit are completed. Plaintiffs proffered
 23 no terms requiring claim construction on May 27. Plaintiffs never tied the need for these
 24 documents as part of the claim construction phase until June 21 – more than a week *after* they

25
 26 ⁵ Plaintiffs have yet to produce documents responsive to eBioscience’s document requests except
 27 those processed and produced in an earlier litigation. Even then, Plaintiffs waited until after
 28 eBioscience moved to stay to produce the documents from the earlier litigation. Thus, as best as
 eBioscience can tell, no party has expended significant time or money in this case processing and
 reviewing all documents responsive to document requests.

1 served their rebuttal claim constructions.

2 **IV. CONCLUSION**

3 Accordingly, eBioscience respectfully requests that the Court deny Plaintiffs' motion to
4 compel the production of documents relating to eBioscience's manufacturing of the accused
5 products.

6
7 Dated: July 1, 2011

/s/ Matthew D. Murphey
Matthew D. Murphey, Esq.
TROUTMAN SANDERS LLP
Attorneys for Plaintiffs/Counterdefendants
LIFE TECHNOLOGIES CORPORATION,
MOLECULAR PROBES, INC., and THE
REGENTS OF THE UNIVERSITY OF
CALIFORNIA

11 Dated: July 1, 2011

/s/ Richard A. Clegg
Richard A. Clegg (SBN 211213)
LAW OFFICE OF RICHARD CLEGG
501 West Broadway, Suite 800
San Diego, California 92101
Telephone: (619) 400-4920
Facsimile: (619) 400-4929
rick@rclegglaw.com

Gary M. Butter (pro hac vice)
Jeffrey D. Sullivan (pro hac vice)
Jennifer C. Tempesta (pro hac vice)
BAKER BOTTS L.L.P.
30 Rockefeller Plaza, 44th Floor
New York, New York 10112-4498
Telephone: (212) 408-2500
Facsimile: (212) 408-2501

Attorneys for Defendant,
EBIOSCIENCE, INC.